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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------|---------------------|------------------|
| 10/526,536  | 03/02/2005  | Terry Wayne Lockridge | PU020411            | 5318             |
| 24498 7590 05/26/2010<br>Robert D. Shedd, Patent Operations<br>THOMSON Licensing LLC<br>P.O. Box 5312<br>Princeton, NJ 08543-5312 |             |                       |                     |                  |
| EXAMINER  |             |                       |                     |                  |
| LEWIS, JONATHAN V   |             |                       |                     |                  |
| ART UNIT  |             | PAPER NUMBER          |                     |                  |
| 2425  |             |                       |                     |                  |
| MAIL DATE   |             | DELIVERY MODE         |                     |                  |
| 05/26/2010  |             | PAPER                 |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/526,536

**Applicant(s)**

LOCKRIDGE ET AL.

**Examiner**

JONATHAN LEWIS

**Art Unit**

2425

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to applicant's amendment filed January 25, 2010. Claims 1-7, 10-16 are still pending in the present application. **This action is made FINAL.**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-7, 10-16 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-2, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art Payton (US Pat. No. 5,790,935) in view of Ellis et al. (US PG Pub. No. 2008/018430).**

**Regarding claim 1** (currently amended), Payton teaches a method for providing a program to a client (Fig. 2 shows the architecture for providing a program to a client), the method comprising the steps of: receiving a request for a pay per view program from the client (col. 3, lines 18-22); determining if the requested program already resides on a local storage device (col. 3, lines 25-27); retrieving the requested program from the local storage device if the requested program resides thereon (col. 3, lines 30-

32); transmitting the retrieved program to the client for display (col. 3, line 31); downloading the requested program from a PPV service provider if the requested program does not reside on the local storage device (col. 6, lines 9-12); and transmitting the downloaded program to the client for display and to the storage device for storage (col. 6, lines 13-19).

Payton teaches all the claim limitations as stated above, except offering at least one of a pause, rewind and fast forward personal video recording service to a client for programs stored in the local storage device; and charging the client a fee for each of the pause, rewind and fast forward personal video recording services requested.

However, Ellis et al. teaches offering at least one of a pause, rewind and fast forward personal video recording service to a client for programs stored in the local storage device (Fig. 2e, 231 shows a local storage device, a PC that stores recorded content as disclosed in paragraph 0074; paragraph 0163 discloses the availability of VCR like controls for recorded programs, including pause, rewind, and fast forward); and charging the client a fee for each of the pause, rewind and fast forward personal video recording services requested (paragraph 0166 discloses the charge for each pause of a program as shown in Fig. 23, and based upon the selection of the pause feature the claim language is satisfied).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to modify Payton to charge for each pause service requested, in order to ensure valuable network resources were only utilized as necessary, while increasing profitability of the service provider.

**Regarding claim 2**, Payton in view of Ellis et al. teaches all the claim limitations as stated above, except the steps of: periodically accessing a PPV page provided by the PPV service provider; determining if a program listed on the PPV page is stored in the local storage device; downloading the program if it is not stored in the local storage device; and transmitting the downloaded program to the storage device for storage thereon.

However, Payton teaches the steps of: periodically accessing a PPV page provided by the PPV service provider (col. 6, lines 59-67); determining if a program listed on the PPV page is stored in the local storage device (col. 6, lines 1-5 discloses the predictive filter 54 performing this function); downloading the program if it is not stored in the local storage device (col. 6, lines 1-5); and transmitting the downloaded program to the storage device for storage thereon (col. 6, lines 11-19).

System **claims 10-11** are rejected for the same reasons as discussed above in the corresponding method claim.

**Claims 3-4, 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art Payton (US Pat. No. 5,790,935) in view of Ellis et al. (US PG Pub. No. 2008/018430) in further view of applicant's admitted prior art Russo (US Pat. No. 6,025,868).**

**Regarding claim 3**, Payton in view of Ellis et al. teaches all the claim limitations as stated above, except the step of: updating a video on demand page in a program guide so the page lists the title of the downloaded program.

However, Russo teaches the step of: updating a video on demand page in a program guide so the page lists the title of the downloaded program (col. 5, lines 55-59 discloses the list, which is a program guide, and the list is updated by displaying only the available programs).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to modify Payton and Ellis to update an on demand program guide, in order to provide an accurate list of available program materials for enjoyment at the user's convenience.

**Regarding claim 4**, Payton in view of Ellis et al. teaches all the claim limitations as stated above, except the step of: updating a video on demand page in a program guide so the page lists the title of the downloaded program.

However, Russo teaches the step of: updating a video on demand page in a program guide so the page lists the title of the downloaded program (col. 5, lines 55-63).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to modify Payton and Ellis to update an on demand program guide, in order to provide an accurate list of available program materials for enjoyment at the user's convenience.

System **claims 12-13** are rejected for the same reasons as discussed above in the corresponding method claim.

**Claims 5-7, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art Payton (US Pat. No. 5,790,935) in view of Ellis**

**et al. (US PG Pub. No. 2008/018430) in further view of applicant's admitted prior art Sedlak et al. (US PG Pub. No. 2002/0108117).**

**Regarding claim 5**, Payton in view of Ellis et al. teaches all the claim limitations as stated above, except the step of: updating a network aggregate profile to reflect the client's request for the stored or downloaded program.

However, Sedlak et al. teaches the step of: updating a network aggregate profile to reflect the client's request for the stored or downloaded program (page 2, 0021 discloses the updating of the content set, the network aggregate profile).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to update the network profile based on a client's request, in order to optimize network resources by decreasing the necessary bandwidth required to supply the user with requested programming.

**Regarding claim 6**, Payton in view of Ellis et al. teaches all the claim limitations as stated above, except the steps of: selecting programs in the network aggregate profile that meet a predetermined criteria; and generating a popular program page in a program guide, the popular program page listing the selected programs.

However, Sedlak et al. teaches the steps of: selecting programs in the network aggregate profile that meet a predetermined criteria (Fig. 6, 606 shows the step of determining the most frequently requested programs); and generating a popular program page in a program guide, the popular program page listing the selected programs (Fig. 4 shows the listing, the grouping of selected programs).

**Regarding claim 7**, Payton in view of Ellis et al. teaches all the claim limitations as stated above, except the predetermined criteria is if the number of times a program has been requested exceeds a predetermined threshold.

However, Sedlak et al. teaches the predetermined criteria is if the number of times a program has been requested exceeds a predetermined threshold (page 1, 0009).

System **claims 14-16** are rejected for the same reasons as discussed above in the corresponding method claims.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Ong US Pat. No. 5,815,662
- b. Shibata et al. US PG Pub. No. 2001/0018772
- c. Ellis et al. US PG Pub. No. 2005/0229213

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN LEWIS whose telephone number is (571)270-3233. The examiner can normally be reached on Mon - Fri 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Pendleton can be reached on (571) 272-7527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian T. Pendleton/  
Supervisory Patent Examiner, Art Unit 2425